REMARKS

The non-final Office Action mailed August 22, 2006, was received and its contents carefully reviewed. Claims 1-26 were originally pending. Applicant amended claims 1, 8, 10, 11, 13-18, and 23 in a previous amendment. Likewise, Applicant canceled claim 2 in a previous amendment. In the current amendments above, Applicants amended claims 1, 8-11, 13-17, and 26 to correct minor informalities in the claims and to highlight additional features of the present invention and add additional context to the claims. These amendments are supported throughout the Specification and at least on page 8, lines 1-15; page 10, lines 7-9; page 16, lines 25-30; and page 17, lines 26-30.

Applicant respectfully submits that no new matter was introduced by these amendments. As now recited, claim 1 and claims 3-26 remain pending and are believed to be in condition for allowance. Applicant respectfully requests reconsideration of this application in light of the above amendments and the following remarks.

A.   Drawings

Applicant thanks the Examiner for the acceptance and acknowledgement of the drawings filed on August 7, 2006.

B.   Claim Rejections Under 35 U.S.C. § 112, second paragraph

Claims 1, 8, 11, 13, and 17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention.

With regard to claim 1, Applicant amended claim 1 above to change the plural "descriptors" to the singular "descriptor" to clarify the enabled descriptor being rendered. Similarly, Applicant amended claim 8 above to change the plural "descriptors" to the singular "descriptor" to clarify the descriptor being enabled. Applicant also amended the claim to more clearly recite selection of the enabled descriptor. Additionally, Applicant amended claims 11 and 13 above to more clearly

recite selection of the enabled descriptor. As well, Applicant amended claim 17 above to more clearly recite the computer program code that renders an enabled descriptor.

In view of the amendments above, Applicant respectfully requests reconsideration and withdrawal of these rejections under 35 U.S.C. § 112, second paragraph.

C.   Claim Rejections Under 35 U.S.C. § 102

Claims 1, 3, 4, 6-9, 17-19, 22 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Shah et al. (WO 01/20466 A1, published 3/22/2001). In view of the amendments above and the comments below, Applicant respectfully requests reconsideration and withdrawal of these rejections.

The present invention pertains to interactive video and specifically to streaming video with on-screen enhancements. For example, amended independent claim 1 now recites a method of rendering <u>an on-content</u> descriptor in association with a streaming media presentation comprising. The recited method of the present invention includes receiving the streaming media presentation, accessing <u>locally-defined</u> descriptor information, determining if <u>a descriptor is</u> enabled, and rendering the descriptor <u>on-content in the streaming media presentation</u> if <u>the descriptor is</u> enabled. The method of the present invention also includes <u>positioning the on-content descriptor with an associated streaming media image element,</u> executing a software routine if an interactive access point is enabled for the <u>on-content</u> descriptor and a corresponding user input is received, and <u>providing a function associated with the on-content descriptor if the software routine is executed, where the function includes at least one of scrolling information, accessing a website, accessing a separate media stream, or saving displayed information.</u> Additionally, the method of the present invention further includes discontinuing display of the <u>on-content</u> descriptor if an end display condition has occurred and also recites that the <u>on-content</u> descriptor comprises text information related to the streaming media image element.

While Shah discloses a method and apparatus for integrating animation in interactive video, Shah fails to disclose all the features of amended independent

claims 1, 8, 10, 11, 13-17, and 26. For example, Shah does not disclose accessing locally-defined descriptors, and instead discloses that authors access different types of annotations (see p. 10, lines 9-25). The author programmed instructions for annotations to appear (see page 12, starting at line 15) rather than locally defining descriptor information as recited in the amended independent claims in the present application. Additionally, there is no disclosure that relates the positioning of the descriptor on-content associated to a streaming media image element.

As illustrated above in amended independent claim 1 and similarly in independent claims 8, 10, 11, 13-17, and 26, Applicant amended the independent claims in the present application to include features not disclosed in the cited references. Namely, none of the cited references disclose accessing locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled.

Applicant amended independent claims 8, 10, 11, 13-17, and 26 to include features substantially similar to those recited above with regard to claim 1. Applicant respectfully submits that these amended independent claims are allowable over Shah for at least the same reasons outlined above with regard to amended independent claim 1. Applicant respectfully requests the reconsideration of claims 1, 8, 17, and 26 and the withdrawal of the rejection under 35 U.S.C. § 102(b).

Dependent claims 3, 4, 6, and 7 depend upon amended independent claim 1, while dependent claim 9 depends upon amended independent claim 8, and dependent claims 18, 19, and 22 depend upon amended independent claim 17. These dependent claims thereby include all the limitations of amended independent claims 1, 8, and 17, respectively, while reciting additional features of the present invention. As noted above, Applicant amended independent claims 1, 8, and 17 to include limitations not disclosed by the Shah reference. Accordingly, with the dependency of claims 3, 4, 6, and 7 upon amended independent claim 1, claim 9 dependent upon amended independent claim 8, and claims 18, 19, and 22 on amended independent claim 17, the Shah reference fails to disclose all of the features recited in dependent claims 3, 4, 6, 7, claim 9, and claims 18, 19, and 22. Applicant respectfully submits that the

10194067.2

reference thereby fails to anticipate claims 3, 4, 6, 7, 9, 18, 19, and 22 under 35 U.S.C. § 102(b) and that these claims are likewise in proper condition for allowance. Applicant respectfully requests the reconsideration of claims 3, 4, 6, 7, 9, 18, 19, and 22 and the withdrawal of the rejection under 35 U.S.C. § 102(b).

D. Claim Rejections Under 35 U.S.C. § 103(a)

1. The Shah et al. Reference Fails to Disclose All the Limitations of Dependent Claim 5.

Claim 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah et al. (WO 01/20466). In view of the amendments above and the comments below, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a).

Dependent claim 5 is dependent upon amended independent claim 1, and thereby includes all the limitations of independent claim 1, while reciting additional features of the present invention. As noted above, Applicant amended independent claim 1 to include limitations not disclosed by the Shah reference. Namely, the Shah reference does not disclose accessing locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled.

Accordingly, with the dependency of claim 5 on amended independent claim 1, Applicant respectfully submits that this claims is likewise in proper condition for allowance and respectfully requests the reconsideration of claim 5 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

2. The Combination of Shah et al. in view of Shema et al. Fails to Disclose All the Limitations of Amended Independent Claim 10 and Dependent Claims 11, 12, 20, and 23.

Claims 10-12, 20 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah et al. (WO 01/20466 A1, published 3/22/2001) in view of Shema et al (US Patent No. 6,766,331, filed 10/4/2001). In view of the amendments

above, Applicant respectfully requests reconsideration and withdrawal of these rejections under 35 U.S.C. § 103(a).

As illustrated above in amended independent claim 1 and similarly in independent claim 10, Applicant amended the independent claims in the present application to include features not disclosed in the cited references. Namely, none of the cited references disclose accessing locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled.

For example, amended independent claim 10 recites a method of rendering <u>an on-content</u> descriptor in association with a streaming media image element including receiving a streaming media presentation, accessing <u>locally-defined</u> descriptor information, determining if <u>a descriptor is</u> enabled, and highlighting <u>a</u> streaming media image element. Amended independent claim 10 further recites a method that includes receiving a user input, rendering the descriptor <u>on-content in the streaming media presentation</u> in a predetermined position <u>that provides an association with the streaming media image element,</u> and discontinuing display of the <u>on-content</u> descriptor if an end display condition has occurred, where the <u>on-content</u> descriptor comprises text information related to the streaming media image element.

As outlined above with regard to amended independent claim 1, Shah fails to disclose accessing locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled. The Shema et al. patent fails to cure these deficiencies. While Shema et al. discloses a method and system for creating and viewing an intelligent graphics file including parts information, there is no disclosure in Shema of the locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled as recited in amended independent claim 10. Applicant respectfully requests the reconsideration of amended independent claim 10 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

Dependent claims 11 and 12 are dependent upon amended independent claim 10, and thereby include all the limitations of independent claim 10, while reciting additional features of the present invention. As noted above, Applicant amended independent claim 10 to include limitations not disclosed by the combination of the Shah reference and the Shema patent. Accordingly, with the dependency of claims 11 and 12 on amended independent claim 10, Applicant respectfully submits that these claims are likewise in proper condition for allowance and respectfully requests the reconsideration of claims 11 and 12 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

Dependent claims 20 and 23 are dependent upon amended independent claim 17, and thereby include all the limitations of independent claim 17, while reciting additional features of the present invention. As noted above, Applicant amended independent claim 17 to include limitations not disclosed by the combination of the Shah reference and the Shema patent. Accordingly, with the dependency of claims 20 and 23 on amended independent claim 17, Applicant respectfully submits that these claims are likewise in proper condition for allowance and respectfully requests the reconsideration of claims 20 and 23 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

3. The Combination of Shah et al. in view of Efrat et al. Fails to Disclose All the Limitations of Claims 13 and 21.

Claims 13 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah et al. (WO 01/20466 A1, published 3/22/2001) in view of Efrat et al (US Patent No. 6,570,587, filed 6/25/1997). In view of the amendments above and the comments below, Applicant respectfully requests reconsideration and withdrawal of these rejections under 35 U.S.C. § 103(a).

As illustrated above in amended independent claim 1 and similarly in amended independent claim 13, Applicant amended the independent claims in the present application to include features not disclosed in the cited references. Namely, none of the cited references disclose accessing locally-defined descriptor information, nor of

rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled.

For example, amended independent claim 13 recites a method of rendering an on-content descriptor in association with a streaming media image element including receiving a streaming media presentation, accessing locally-defined descriptor information, determining if a descriptor is enabled, and receiving pointing device position information related to a displayed cursor. Amended independent claim 13 further recites a method that includes altering the appearance of the displayed cursor if the pointing device position information of the displayed cursor corresponds to a streaming media image element for which an enabled descriptor is available, receiving a user input, selecting the enabled descriptor from said locally-defined descriptor information using said pointing device position information, rendering the selected descriptor on-content in the streaming media presentation in a predetermined position that provides an association with the streaming media image element, and discontinuing display of the on-content descriptor if an end display condition has occurred, where the on-content descriptor comprises text information related to the streaming media image element.

As outlined above with regard to amended independent claim 1, Shah fails to disclose accessing locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled. The Efrat et al. patent fails to cure these deficiencies. While Efrat discloses a method and system and linking information to a video, there is no disclosure in Efrat of the locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled as recited in amended independent claim 13. Applicant respectfully requests the reconsideration of amended independent claim 13 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

Dependent claim 20 is dependent upon amended independent claim 17, and thereby includes all the limitations of independent claim 17, while reciting additional features of the present invention. As noted above, Applicant amended independent

10194067.2

claim 17 to include limitations not disclosed by the combination of the Shah reference and the Efrat patent. Accordingly, with the dependency of claim 20 on amended independent claim 17, Applicant respectfully submits that this claim is likewise in proper condition for allowance and respectfully requests the reconsideration of claim 20 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

4. The Combination of Shah et al. in view of the Java Boutique Article Fails to Disclose All the Limitations of Claims 14-16, 24, and 25.

Claims 14-16, and 24-25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah et al. (WO 01/20466 A1, published 3/22/2001) in view of the Java Boutique article (Java Boutique, "The Java Boutique –Imap.java", pp 1-2). In view of the amendments above and the comments below, Applicant respectfully requests reconsideration and withdrawal of these rejections under 35 U.S.C. § 103(a).

As illustrated above in amended independent claim 1 and similarly in amended independent claims 14-16, Applicant amended the independent claims in the present application to include features not disclosed in the cited references. Namely, none of the cited references disclose accessing locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled.

For example, amended independent claim 14 recites a method of rendering <u>an on-content</u> descriptor in association with a streaming media image element including receiving a streaming media presentation, accessing <u>locally-defined</u> descriptor information, displaying a <u>first</u> streaming media image element identifier in a first screen position within <u>the</u> streaming media <u>presentation,</u> and displaying a <u>first on-content</u> descriptor associated with the <u>first</u> streaming media image element in a second screen position <u>associated with the first streaming media image element and within the streaming media image presentation.</u> Amended independent claim 14 further recites that the method includes <u>executing a software routine if an interactive access point is enabled for the first on-content descriptor and a corresponding user input is received and providing a function associated with the first on-content descriptor if the software</u>

routine is executed, the function including at least one of scrolling information, accessing a website, accessing a separate media stream, or saving displayed information and where the on-content descriptor comprises text information related to the first streaming media image element.

As outlined above with regard to amended independent claim 1, Shah fails to disclose accessing locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled. The Java Boutique article fails to cure these deficiencies. While Java Boutique discloses a Java applet for pop up help windows on image maps, there is no disclosure in Java Boutique of the locally-defined descriptor information, nor of rendering and positioning the descriptor on-content in the streaming media presentation if the descriptor is enabled as recited in amended independent claim 14.
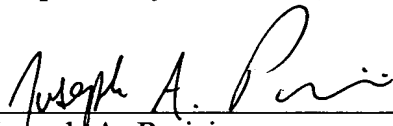
Claims 15 and 16 were similarly amended to include these features as well. As such, Applicant respectfully submits that the combination of Shah in view of the Java Boutique article fails to disclose all the limitations of amended independent claims 14-16. As such, Applicant respectfully requests the reconsideration of amended independent claims 14-16 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

Dependent claims 24 and 25 are dependent upon amended independent claim 17, and thereby include all the limitations of independent claim 17, while reciting additional features of the present invention. As noted above, Applicant amended independent claim 17 to include limitations not disclosed by the combination of the Shah reference and the Java Boutique article. Accordingly, with the dependency of claims 24 and 25 on amended independent claim 17, Applicant respectfully submits that these claims are likewise in proper condition for allowance and respectfully requests the reconsideration of claims 24 and 25 and the withdrawal of the rejection under 35 U.S.C. § 103(a).

E. Conclusion

Applicant respectfully requests that the Examiner reconsider and withdraw the rejections of record and allow claim 1 and claims 3-26 in the present application to issue. If the Examiner believes that a conference would be beneficial in expediting the prosecution of the present application, Applicant invites the Examiner to telephone counsel to arrange such a conference.

Respectfully submitted,

Joseph A. Parisi
Registration No. 53,435

NIXON PEABODY LLP
Suite 900, 401 9th Street, N.W.
Washington, D.C. 20004-2128
(202) 585-8000